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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,255	11/16/2001	Ken Johnson	6634.02	3008

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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,255

Applicant(s)

JOHNSON, KEN

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/16/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

No description of Figures 9, 18 and 23-34 is provided in the Detailed Description of the specification.

The specification refers to Appendix A on p. 21. However, there is no appendix provided in the disclosure..

Appropriate correction is required.

Claim Objections

Double Patenting

2. Claims 14-16 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 17-19. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Note that the preamble is not given any weight in each case as no limitation of each of the claims in any way distinguish the claimed inventions from each other and achieve the stated objective set forth in the preamble.

Claim Rejections - 35 USC § 112

3. Claims 10-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As an example claim 10 recites in its preamble "an automated system for generating quote for a piece of leased equipment". The claim fails to recite any element(s) of the system, which would perform the stated objective of generating a quote.

The claim in limitation (b) merely states "the server adapted toprocess the terms" without indicating what "processing" entails. This limitation, therefore, renders the claim indefinite.

Dependent claims 11-13 also inherit same deficiency as parent claim 10.

Similar analysis also applies to independent claims 14 and 17 and their respective dependent claims.

4. Claims 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 7-9 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: electronically receiving and storing in a server the terms for the lease. Step (c) requires that the appropriate data

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(i.e. data solicited in step (a)) be received in order that computing is facilitated by the server.

Dependent claims 8 and 9 also inherit same deficiency.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-5, 7, 8, 10, 11, 13, 14, 17 and 20 are rejected under 35 U.S.C. 102(a) as being anticipated by Trinity Business Group (refer to web site www.trinitybusinessgroup.com dated April, 28 1999 (Trinity)).

Per claim 1, Trinity discloses an automated method for generating a quote for a piece of leased equipment, the method comprising:

(a) electronically soliciting from a client terms for a lease for a piece of leased equipment ... (clients are vendors listed on p.1 who agreed to use services of Trinity, terms and conditions are those of the vendors who posted their equipment for lease because Trinity acts as an agent that facilitate leasing to clients through the Internet as inherently disclosed in the reference).

(b) electronically receiving and storing... the terms for the lease (refer to terms on p.1)

(c) computing payment terms for the lease... (refer to terms including structure, term, rates, options on p.1)

(d) generating report at the client showing the payment terms for the lease (this term is inherent because it is anticipated that Trinity would communicate the agreement of lease to the vendors prior to posting on the Internet website).

Claim 2. generating documentation for the piece of leased equipment ... (since Trinity facilitates lease of equipments such as a vehicle, it is anticipated that it includes a document such as a lease agreement which is to be reviewed, endorsed and authorized by a signature of the lessee).

Claims 3 and 4 : terms for lease include a capital cost, a residual, a dealer fee, a documentation fee, upfront fees, length of lease in months and type of asset (these are customary items of a lease agreement and are anticipated by the Trinity reference). Claim 4 is similarly analyzed as claim 3.

Claim 5: ..receiving the terms for the lease Over the Internet (Trinity web site stores the terms of the lease for each vendor, thus inherently communication occur over the Internet).

Claim 7: Trinity discloses an automated method for leasing a vehicle comprising:
Steps (a) – (c) have been anticipated over Trinity as discussed in claim 1 analysis.

Step (d) receiving at the server instructions from a client to go forward with the lease, is inherent in Trinity reference because the vendors (entities offering listed products on p. 1) because these products are made available to potential a potential lessee.

Regarding steps (e)- (f), since Trinity provides leasing of vehicles (p.1 "vehicle equipment"), step (e) electronically soliciting from the lessee... the client basic identification information... individual user of the leased vehicle and (f) receiving and storing.. the client basic identification information (p.1 details of lease program on a web page on the Internet is solicitation from the lessee receiving and storing at the server the client basic identification information are inherent because it is customary practice in vehicle lease process).

Trinity, also teaches steps (g)-(h) scoring the lessee's credit using external credit checking databases (100 financing p.2 which require credit checking through Equifax, TRW etc. or other external credit reporting facilities) and since Trinity provides leasing service for vehicles (and other industrial equipment) step (i) is anticipated as documentation for the vehicle lease as being inherent to the process of leasing the vehicle.

Claim 8. Refer to claim 5 analysis.

Claim 10: Trinity discloses an automated system for generating a quote for a piece of leased equipment, the system comprising:

A user interface (inherently a computer, such as a personal computer which accesses the web page via the Internet);

A server adapted to electronically receive terms of a lease from the user interface, store the terms, process the terms and generate reports (Trinity web site performs these functions, refer to the reference p.1 -3 and claims 1 and 7 analysis for further details);

A communication path (Trinity website is linked to any user who can access the website via the Internet).

Claim 11. Refer to claim 2 analysis.

Claim 13. Refer to claim 3 analysis.

Claims 14 and 17. Refer to corresponding method claim limitations of claim 7.

Claim 20. all limitations of claim 20 have been analyzed as per method claim 7.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6, 9, 12, 15, 16, 18, 19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trinity Business Group (refer to web site www.trinitybusinessgroup.com dated April, 28 1999 (Trinity).

Claims 6, 9 Trinity fails to teach that electronically receiving the information through an interactive telephone response system. However, official notice is taken that

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conducting business transactions over the interactive telephone response system (such as receiving quotes for merchandise, ordering merchandise, catalogue ordering) is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to carryout the lease process as disclosed in Trinity reference using an interactive telephone response system because allowing access over the interactive telephone response system would enable clients who do not have access to a networked computer system to access the leasing system via a telephone network such as PBX. This would also thus allow more potential customers access to the lease server.

Claims 12, 15, 18 and 21: Trinity discloses the claimed invention as recited in independent claim 10 except it fails to recite an external server as recited herein. The claim does not recite any functionality of the external server other than "communication between the user and the server" which present in the Trinity server as discussed earlier. It would have been obvious matter of design choice to implement the external server, since the applicant has not disclosed that the presence of the external server solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without the external server.

10. Claims 16, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trinity as applied to claim 14 and further in view of Zoffel et al (US Pat. 5,274,547).

Claims 16, 19 and 22: Trinity fails to disclose a second communication path linking the server as recited. In the same field of endeavor, however, Zoffel, discloses a

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system of generating credit reports which comprises a communication path 44 connecting a personal computer to a host computer (server) and a second communication path 46 linking the server to an external data source (CBI 20, TRW 32, and TRANS UNION 34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide for a second communication path as disclosed by Zoffel because it would allow the server to receive data pertinent to credit rating for a lessee or for processing of lease application or for generating a quote for a leased equipment by the server.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

PR NEWSWIRE, Advanta Business Services Launches Forte-Based E-Commerce Leasing Tool to Speed Customer Service, October 13, 1998

Business Wire, Chancellor Capitalizes Upon E-Commerce Industry With Online Lease Applications, March 1, 1999

Joao (US Pat. 6,347,302) discloses an apparatus and method for processing lease insurance information.

Anderson (US Pat. 5,774, 883) teaches a transaction management system which may be used by a vehicle dealership to evaluate a customer's credit risk, budgetary factors and profitability of the sale of a vehicle.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.

A handwritten signature in black ink, appearing to read 'Jagdish N. Patel', with a stylized flourish at the end.

Jagdish N. Patel

(Examiner, AU 3624)

October 18, 2002